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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,226	04/01/2004	Gary J. Ford	07890010US	5374

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EXAMINER

PIERCE, WILLIAM M

ART UNIT PAPER NUMBER

3711

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/814,226

Applicant(s)

FORD ET AL.

Examiner

William M. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-32 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-32 and 34-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION*****Claim Objections***

Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim is functional in that it only sets forth the intention of how it is to be made while not further limiting a structural element of a previously recited.

***Claim Rejections - 35 USC § 102***

Claims 1, 8, 9, 12, 19, 24, 25, 30, 31 and 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by De Vore 2,969,983 as set forth in the previous office action.

"As to claims 1, 8, 19, 24, 25, 30, 31 and 37-39 DeVore shows wooden boards 47 held together by adhesive "between the contacting surfaces" (col. 5, ln. 59). As to claim 9, an underlayment 41 is shown. The underfloor 41 is adhesively secured to the boards as called for by claim 12 (col. 6, ln. 3)."

Up to pg. 12 of Applicant's arguments, they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. On pg. 12 he states that DeVore is not prefabricated. But does not point to the limitations in the claim to which he refers. Using claim 1 for example, the preamble recites prefabricated and the last line recites "preformed". However, such terms absent any further structural limitations are given their broadest most reasonable interpretation. Here "prefabricated" can be taken so broad to read as "fabricated before use". Using such an interpretation DeVore reads on the claims recited. Since "prefabricated" recites no structure, at best, it is considered functional and how it is made. From that point of view, it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Structurally, DeVore shows the claimed invention and how and where it is made cannot be used to distinguish over the applied art which shows the structure that is claimed. Further the boards of DeVore are "bonded to each other along their sides" as the "adhesive 51 and 52 penetrates the adjacent surfaces of the boards in establishing a bond between them" (col. 5, ln. 6) in contrast to applicant's interpretation. Hence, since applicant's invention, claimed as an apparatus, must distinguish over the applied art by what it is and not by how it is made, he fails to distinguish over DeVore.

Even assuming any weight were to be given to the term prefabricated to mean manufactured off site and installed as an assembled piece, such is submitted as old in bowling to use preformed replacement panels to repair

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bowling alleys. See Heddon 4,169,602 by way of example. The motivation to prefabricate a product built on site is well known in order to be able to factory build the majority of the components and eliminate the need to build them on site. This is not a novel and inventive advance. The housing industry has found it very practical in cases to manufacture houses and deliver them to the site rather than build on the site. Hence, with that in mind, the examiner can offer no suggested changes to the claims that would overcome DeVore.

As set forth above, DeVore discloses the use of adhesive "between the boards" as it penetrates during the building process. Col 5, Ln. 57+ goes into more detail that "the adhesive...is to a certain extent forced between the contacting surfaces of said boards...not only securing the contacting lower surfaces of the alley boards but likewise and simultaneously securing the said boards to one another". As such this argument is clearly unpersuasive.

#### ***Claim Rejections - 35 USC § 103***

Claims 2-5, 7, 10, 17, 18, 20- 23, 26-29, 32, 35-37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Vore as set forth in the previous office action..

"The size of the boards in claims 2, 3, 26 and 27 is considered an obvious matter of choice and has not being shown to be critical. DeVore shows an approach section 10 as called for by claim 4. The size of the approach as called for in clam 4, 17, 18 and 28 is considered an obvious matter of choice. DeVore teaches the use of any suitable adhesive (col. 4, ln. 55) to meet the limitations of claims 5 and 29. As to claims 7 and 40, the use of synthetic materials in place of wood is well known. As to claims 10, 11 and 32, the use of fiberboard, such as OSB Oriented Strand Board in place of plywood is old and well known. As to clams 20, 21, 35 and 36, counter sunk screws and plugs are well known mechanical fasteners. To have replaced the adhesive of DeVore with that of a mechanical fastener would have been obvious to have replace one known mechanical fastening expedient for that of another. The use of dowels for range finders as called for in claim 22 and 37 is old and well known. As to claim 23, the use of mortise and finger joints to connect two wood elements together is considered to be old and well known. To have use a finger joint in DeVore would have been obvious in order to obtain a stronger joint."

DeVore clearly contemplates the use of fasteners in his "sub-baseboard 33 is secured along its edges to each of the transverse beams 25 by means of screws" (col. 4, ln. 24). Pre-drilling for screw fasteners is old, well known and not considered a patentable advance. With respect to the "materials not invented" at the time of DeVore, it is known to be obvious to use a material to take advantage of its known properties. To apply newly available materials for their intended purpose to old products is not inventive and has been held obvious.

Claims 14-16, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVore in view of Heddon 5,348,513 as set forth in the previous office action..

"Devore does not detail his foul line 12. Heddon teaches the use of embedded foul lines at the edge of lane panels. To have used a separated bonded piece as foul line 12 in DeVore would have been obvious method of making foul lines known in the art."

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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov). The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**